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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* BRIAN J. REISTAD, ESWAR PRIVADARSHAN,  
9 MICHAEL P. MITCHELL, JIM W. O'TOOLE, ANDREW C. PAYNE,  
10 DURVAL M. VIETRA, and LARRY C. STEWART  
11

12  
13 Appeal 2008-3163  
14 Application 09/054,180  
15 Technology Center 3600  
16

17  
18 Decided: December 23, 2008  
19

20  
21 *Before* ANTON W. FETTING, DAVID B. WALKER, and JOSEPH A.  
22 FISCHETTI, *Administrative Patent Judges*.

23  
24 FETTING, *Administrative Patent Judge*.  
25

26  
27 DECISION ON APPEAL

28 STATEMENT OF THE CASE

29 Brian J. Reistad, Eswar Privadarshan, Michael P. Mitchell, Jim W.  
30 O'Toole, Andrew C. Payne, Durval M. Vietra, and Larry C. Stewart  
31 (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims  
32 12-36 and 39-63, the only claims pending in the application on appeal.

1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)  
2 (2002).

3  
4 We REVERSE.

5 The Appellants invented a way to transmit to a server computer an  
6 order acceptance request that includes a plurality of terms or conditions of a  
7 proposed offer for a purchase, including multiple options of at least one of  
8 the terms or conditions of the offer. The server computer is programmed to  
9 process the order acceptance request based on pre-programmed criteria and,  
10 based on the processing of the order acceptance request, to transmit to the  
11 client computer an order acceptance response that includes an amendment to  
12 the proposed offer for the purchase (Specification 1:27 – 2:3).

13 An understanding of the invention can be derived from a reading of  
14 exemplary claim 12, which is reproduced below [bracketed matter and some  
15 paragraphing added].

16 12. An electronic commerce system comprising:  
17 [1] a client computer; and  
18 [2] a server computer;  
19 [3] the client computer and the server computer being  
20 interconnected by a public packet switched communications  
21 network;  
22 [4] the client computer being programmed to transmit to the  
23 server computer an order acceptance request comprising a  
24 plurality of terms or conditions of a proposed offer for a  
25 purchase,  
26 the order acceptance request comprising a discrete  
27 message that includes a plurality of modular elements  
28 whose individual integrity is protected by  
29 embedding cryptographic security codes within  
30 each of the modular elements,

at least one of the modular elements individually protected by a cryptographic security code being a digital coupon;

[5] the server computer being programmed to process the order acceptance request based on pre-programmed criteria, including authentication of the cryptographic security codes embedded within each of the modular elements and examination of the modular elements of the discrete message individually protected by the cryptographic security codes, and,

based on the processing of the order acceptance request, to transmit to the client computer an order acceptance response based on the pre-programmed criteria,

the order acceptance response comprising a discrete message transmitted during a negotiation phase of a transaction

that includes a plurality of modular elements whose individual integrity is protected by embedding cryptographic security codes within each of the modular elements;

[6] wherein the client computer is programmed to receive the digital coupon, protected by a cryptographic security code, from another computer.

This appeal arises from the Examiner's Final Rejection, mailed June 14, 2006. The Appellants filed an Appeal Brief in support of the appeal on April 16, 2007. An Examiner's Answer to the Appeal Brief was mailed on September 21, 2007. A Reply Brief was filed on November 21, 2007.

## PRIOR ART

The Examiner relies upon the following prior art:

Barnett                      US 6,321,208 B1                      Nov. 20, 2001

REJECTION

Claims 12-36 and 39-63 stand rejected under 35 U.S.C. § 102(e) as anticipated by Barnett.

ISSUE

The issue pertinent to this appeal is whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 12-36 and 39-63 under 35 U.S.C. § 102(e) as anticipated by Barnett.

The pertinent issue turns on whether the art applied shows an order acceptance request and response that both include a plurality of modular elements whose individual integrity is protected by embedding cryptographic security codes within each of the modular elements.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Barnett*

01. Barnett is directed to the electronic distribution of secure money saving or discount coupons and other marketing incentives. Barnett describes the use of a centrally located online computer system for interactively distributing such coupons to remotely connected consumer computers and for collecting user-specific data regarding coupon usage and user demographic information from the remote computers (Barnett 1:6-13).
02. Barnett shows a client and server interconnected by a public packet switched communications network (Barnett Fig. 1).

1           03. Barnett describes how a user can order a package of electronic  
2           coupons from the online service provider. Commands are  
3           generated and transmitted via a data communications interface and  
4           a data link, and up to the coupon package file resident at the  
5           online service provider. The requested coupon data package and  
6           associated advertising materials are transmitted by the online  
7           service provider to the personal computer, where it is stored in the  
8           downloaded coupon data file in a coupon database (Barnett 8:22-  
9           33).

10          04. In addition to the usual coupon information found in prior art  
11          coupons, Barnett's coupons contain user-specific data in the form  
12          of a unique user bar code encoded with user-specific information  
13          such as the user name and/or other unique identification criteria  
14          such as a social security number or online service address. This  
15          information renders each printed coupon unique, since an  
16          otherwise similar coupon presented by a different consumer will  
17          comprise a different user bar code. This is one aspect of what  
18          Barnett refers to as the secure nature of its invention (Barnett  
19          7:21-35).

## 21                                   PRINCIPLES OF LAW

### 22          *Claim Construction*

23           During examination of a patent application, pending claims are  
24           given their broadest reasonable construction consistent with the  
25           specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In*  
26           *re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

1 Limitations appearing in the specification but not recited in the claim are  
2 not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,  
3 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the  
4 specification” without importing limitations from the specification into the  
5 claims unnecessarily).

6 Although a patent applicant is entitled to be his or her own lexicographer  
7 of patent claim terms, in *ex parte* prosecution it must be within limits. *In re*  
8 *Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing  
9 such definitions in the specification with sufficient clarity to provide a  
10 person of ordinary skill in the art with clear and precise notice of the  
11 meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480  
12 (Fed. Cir. 1994) (although an inventor is free to define the specific terms  
13 used to describe the invention, this must be done with reasonable clarity,  
14 deliberateness, and precision; where an inventor chooses to give terms  
15 uncommon meanings, the inventor must set out any uncommon definition in  
16 some manner within the patent disclosure so as to give one of ordinary skill  
17 in the art notice of the change).

#### 18 *Anticipation*

19 "A claim is anticipated only if each and every element as set forth in  
20 the claim is found, either expressly or inherently described, in a single prior  
21 art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d  
22 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or  
23 compositions, either generically or as alternatives, the claim is deemed  
24 anticipated if any of the structures or compositions within the scope of the  
25 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.  
26 Cir. 2001). "The identical invention must be shown in as complete detail as

1 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d  
2 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by  
3 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology  
4 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

5  
6 ANALYSIS

7 *Claims 12-36 and 39-63 rejected under 35 U.S.C. § 102(e) as anticipated by*  
8 *Barnett.*

9 The Examiner found that Barnett described the client transmission of  
10 limitation [4] during coupon request and the server processing of limitation  
11 [5] at coupon redemption (Answer 3-4). Whether Barnett describes the  
12 client, server and network of limitations [1]-[3] is not under contention.

13 The Appellants contend that Barnett has no description of embedding  
14 cryptographic security codes within each of multiple modular elements (Br.  
15 22-24); that except for a minimal reference to electronic redemption, all of  
16 Barnett's described coupon redemption processing is with printed coupons,  
17 negating the electronic processing of limitation [5] (Br. 24) thereby also  
18 negating any description of the security codes embedded in the server  
19 response of limitation [5] (Br. 24-25); and that Barnett does not describe a  
20 third computer which the Appellants argue is required by limitation [6]'s  
21 "another computer" (Br. 25).

22 The Examiner relied on Barnett's encoding of data into bar codes to  
23 satisfy the requirements for cryptographic security codes (Answer 3-4).  
24 Irrespective of whether such codes might encompass such bar codes, we do  
25 not agree that Barnett describes the use of cryptographic security codes in  
26 both the client transmission and server response.



The Examiner found that the claimed acceptance order request in Barnett occurred when a coupon was requested (Answer 3: second line from bottom). Since Barnett's bar code data is part of a coupon, such cryptographic data would not be part of the proposed order acceptance request, i.e., the coupon request. Indeed, the request for a coupon would not even be a coupon as required by limitation [4]. Alternatively, if the order acceptance request were the coupon transmitted by Barnett, then Barnett provides no response to that request as required by limitation [5]. The Examiner appears to be relying on the same portions of Barnett, column 7, lines 20-55 for the cryptographic security of both the request and response. This portion of Barnett describes the transmission of the coupon only, and does not describe a second responsive transmission with any cryptographic encoding.

## CONCLUSIONS OF LAW

The art applied does not show an order acceptance request and response that both include a plurality of modular elements whose individual integrity is protected by embedding cryptographic security codes within each of the modular elements. The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 12-36 and 39-63 under 35 U.S.C. § 102(e) as anticipated by Barnett.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 12-36 and 39-63 under 35 U.S.C. § 102(e) as anticipated by Barnett is not sustained.

REVERSED

hh

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